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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/050,848	01/18/2002	Norman G. Anderson	2315-148	3044

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EXAMINER

LU, FRANK WEI MIN

ART UNIT	PAPER NUMBER
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1634

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

10/050,848

Applicant(s)

ANDERSON ET AL.

Examiner

Frank W Lu

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 01 September 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached office action.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: \_\_\_\_\_

Claim(s) withdrawn from consideration: \_\_\_\_\_

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

## ADVISORY ACTION

### *Response to Arguments*

I. In page 5, first and second paragraphs of applicant's remarks, applicant argues that: (1) "[T]he examiner considers the claimed 'lower region' to include part of what Davis et al calls the 'gripping section 40' and the 'upper section 22'. See column 4, lines 55-58. Applicants submit that it is an incorrect interpretation of Davis et al. The 'lower region' in Davis is the lower tip section 30. The upper region is 22. See column 3, lines 18-20. It is an improper interpretation of Davis to conclude that 'supper region 20' and part of the gripping region 40 constitute a 'lower region' as presently claimed. It is unreasonable to conclude that what the reference considers an 'upper region' is the same as a 'lower region'. For Davis et al to call something an upper region implies that a lower region is also present and that it is somehow different from the upper region. It would be against the teachings in Davis et al to argue that an upper region is a lower region".

This argument has been fully considered but it is not persuasive toward the withdrawal of the rejection. Although Davis et al., calls 40 and 22 as the gripping section 40 and the upper section 22 (see Figure 5), in view of Figure 5, the examiner can interpret upper region, middle region and lower region differently and does not based on what 40 and 22 are called by Davis et al.. Therefore, the rejection is reasonable.

II. In page 5, last paragraph bridging to page 6, fourth paragraph of applicant's remarks, applicant argues that Davis *et al.*, do not teach parallel inner sides.

This argument has been fully considered but it is not persuasive toward the withdrawal

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of the rejection because Davis *et al.*, do teach parallel inner sides (see column 4, lines 52-61 and attached Figure 5 with the examiner's handwritings from previous final office action).

III. In page 6, fifth paragraph of applicant's remarks, applicant argues that "[F]urthermore, Davis does not teach a middle region having one or more serrations as claimed in claim 19.

While the examiner asserts that the "score" in Fig. 1 to be a serration, this is not consistent with the teaching of Davis as explained in the previous response filed March 1, 2004. However if one persists in calling score 16 a serration then it should be emphasized that this score occurs on the conical shaped tube of Fig. 1 and maybe implied in Fig. 2. Neither tube of Fig. 1 nor Fig. 2 has parallel side walls at any point for any region at all. Therefore, one does not have any disclosure that would anticipate a serration of any type (even one different from the claimed invention) in a tube with parallel side walls at any portion, much less at certain specific claimed regions".

This argument has been fully considered but it is not persuasive toward the withdrawal of the rejection. First, since, according to the dictionary, "serrate" means "notched or toothed" (see the attached dictionary in previous office action) and Davis *et al.*, teach that another alternative embodiment of the centrifuge tube 10, score 16, includes a notch (see Figures 1 and 2, lines 65-68 in column 3, and lines 1-3 in column 4), claim 19 is anticipated by Davis *et al.*.

Second, since serration taught Davis *et al.*, is one of embodiments in the patent, serration taught Davis *et al.*, can apply to different centrifuge tubes taught by Davis *et al.*, (see Figures 1-7) and serration taught by Davis *et al.*, is not limited to a conical shaped tube as suggested by applicant.

IV. In page 6, last paragraph bridging to page 7, first paragraph of applicant's remarks, applicant argues that "claim 20 recites that the lower region has the ability to trap an air bubble between two liquids of liquid. Contrary to the examiner's assertion, this is a structural

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limitation as it prevents the tube from having a structure so large or configured to prevent an air bubble from being held. For example a tube five inches wide will not hold an air bubble in an aqueous solution. The lower section of Davis is angled as stated above and is very unlikely to be able to hold an air bubble because the tube sides are not on the sides or top of the air bubble to prevent it from rising by friction”.

This argument has been fully considered but it is not persuasive toward the withdrawal of the rejection. First, the examiner does not agree with applicant that trapping an air bubble between two liquids is a structural limitation because trapping an air bubble is an ability of a centrifuge tube which is a functional limitation. It is known that a claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987) and while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (see MPEP 2114). Since Davis *et al.*, teach all structure limitations recited in claims 18 and 20, claim 20 is anticipated by Davis *et al.*.

V. In page 7, second to fourth paragraphs of applicant’s remarks, applicant argues that Simmonds *et al.*, Sanders *et al.*, and Davis *et al.*, do not correct for the deficiencies in Davis *et al.* in the initial rejection discussed above or alter the teachings of Davis *et al.*, to suggest the recitations in claims 18, 19 and 20 argued above.

This argument has been fully considered but it is not persuasive toward the withdrawal

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of the rejection. As shown above arguments, Davis *et al.*, do teach all limitations recited in claims 18-20 and the references from Simmonds *et al.*, Sanders *et al.*, and Davis *et al.*, were used in the rejections under 35 U.S.C 103 and were not used in the rejection under 35 U.S.C 102.


2. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CAR § 1.6(d)). The CM Fax Center number is either (703)872-9306.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Lu, Ph.D., whose telephone number is (571)272-0746. The examiner can normally be reached on Monday-Friday from 9 A.M. to 5 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion, can be reached on (571)272-0782.

Any inquiry of a general nature or relating to the status of this application should be directed to the Chemical Matrix receptionist whose telephone number is (703) 308-0196.

Frank Lu  
PSA  
October 4, 2004

  
GARY BENZION, PH.D.  
SUPERVISORY PATENT EXAMINER  
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